



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/863,047	05/23/1997	FUMIAKI ITO	35.C12088	4264
5514 7590 07/17/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
07/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/863,047

Applicant(s)

ITO ET AL.

Examiner

Ella Colbert

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 9, 10, 12, 13 and 17-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 9, 10, 12, 13, and 17-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1, 4, 9, 10, 12, 13, and 17-46 are pending. Claims 1, 4, 9, 10, 12, 13, and 17-46 have been amended in this communication filed 4/28/08 entered as Response After Non-Final Action. Claims 2, 3, 5-8, 11, 14-16, and 47-70 have been cancelled in either this communication or a prior communication.
2. The claim objections for claims 4, 10, 13, 17-46 have been overcome from the prior Office Action and are hereby withdrawn. However, there are remaining claim objections necessitated by the amendment as set forth here below.
3. The 35 U.S.C. 112, First Paragraph still remains for claims 1, 3, 4, 9, 10, 12, 13, and 17-46 as set forth here below.

Claim Objections

4. Claims 1, 9, 12, 17, 23, and 29 are objected to because of the following informalities:

Claim 1 recites "into a selected folder selected by a user among the at least ...". This claim limitation should recite "into a selected folder selected by a user from among the at least ...". Claims 9 and 12 have a similar problem. Claim 17 recites in line 3 "saving of the new document in the candidate folder". This line would be better recited "saving the new document in the candidate folder." Claims 23 and 29 have a similar problem. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 3696

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3, 4, 9, 12, 15, 16, 19, 25, 31, 36, 37, 39- 45, 63, 65, 67, and 68-70 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the Specification and drawings that the searcher is a device and not a human being. The specification recites on page 7 lines 1-6 "represents a folder searcher for searching folders retained in the folder/document retainer 101 ...". Reference numeral 109 represents a search result ... the folder searched by the folder searcher 108". "Search device " is a very broad term and can read on a "search template" or any other device that is capable of searching such as described in non-patent reference "Navigational Utilities: finding your way through the maze (includes directory) (product watch) (buyers guide) by Waltz, Mitze; MacWeek, v. 6, n.29; August 10, 1992; page 1, para. 3-page 2, para 10 and para. 13 –page 3, para. 2.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim1, 3, 4, 9, 10, 12, 13, 15-46, 63, 65, and 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,418,946) Mori in view of Non-Patent reference Waltz, Mitzi, hereafter Waltz.

Claims1, 9, and 12. Mori discloses, A document processing system comprising: folder retainer means for retaining a plurality of folders, each of the folders storing at least one document (col. 4, lines 7-25); new document retainer means for retaining a new document (col. 4, lines 26-40); a folder search device for searching the plurality of folders to identify at least one candidate folder from the plurality of folders suitable for storing the new document, by comparing a feature of the new document with an average of features of the documents stored in at least one candidate folder among the plurality of folders, wherein the at least one candidate folder has documents more similar to the new document than other documents in the plurality of folders (col. 4, line 41-col. 5, line 20); and controlling means for controlling to store the new document into a selected folder selected by a user from the plurality of folders searched by said folder search device (col. 6, lines 25-47 and col. 9, lines 30-62). Mori did not expressly disclose a search device. However, a search device is well known in the art of searching for documents as discussed in Waltz.

Claim 3. Mori discloses, The document processing system according to claim 1, wherein a plurality of candidate folders suitable for saving the new document are searched and a list of a plurality of searched candidate folders is displayed (col. 7, line 31-col. 9, line 24).

Claims 4,10, and 13. Mori discloses, wherein prior to the searching of a plurality of

folders, said folder search device judging a similarity degree representing a similarity between a feature of the new document and an average of features of the plurality of documents stored in each folder (col. 9, lines 30-62) so that the judged similarity degree is used when a feature of the new document is compared with an average of features of the plurality of documents (col. 9, lines 47-62).

Claims 15 and 16. Mori discloses, wherein a plurality of candidate folders suitable for saving the new document are searched and a list of a plurality of searched candidate folders is displayed (col. 9, lines 11-24).

Claims 17, 23, and 29. Mori discloses, further comprising means for updating the feature of the folder in response to saving of the new document in the candidate folder (col. 9, lines 30-46).

Claims 18, 24, and 30. Mori discloses, wherein the document includes vector data (col. 7, line 67-col. 9, line 4) .

Claims 19, 25, and 31. Mori discloses, wherein the candidate folder has a high-level rank as determined by the result of the search by said folder searcher (Fig. 6 (601)).

Claims 20, 26, 32, 37, and 41. Mori discloses, wherein said notifying means displays a label which is set in advance to indicate the candidate folder (Fig. 6 (601)).

Claims 21, 27, 33, 38, 42, and 46. Mori discloses, wherein the document includes text data (Fig. 6 (606)).

Claims 22, 28, and 34. Mori discloses, further comprising means for causing the selected candidate folder to save the new document (Fig's 9 and 12)).

Claims 35 and 43. Mori discloses, further comprising notifying means for notifying a

user of the at least one candidate folder by said folder searcher wherein said notifying means provides notification only of a predetermined number of folders which have a high rank of similarity order (Fig. 6-shows a predetermined number of folders with a high rank of similarity order).

Claims 36 and 44. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher wherein the document is stored in at least one folder mentioned in the notification provided by said notifying means (col. 9, line 66-col. 10, line 30).

Claims 37 and 41. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher wherein said notifying means displays a label set in advance to the selected folder (Fig's 6-9 and 12-19 shows a label that can be set in advance to the selected folder).

Claims 63, 65, and 67. Mori discloses, wherein said notifying means notifies of only the plurality of candidate folders searched by said folder searcher means to a user (col. 6, lines 13-34).

Claims 68-70. Mori discloses, further comprising notifying means for notifying a user of the at least one candidate folder by said folder searcher (col. 7, lines 16-64).

Response to Arguments

Issue no. 1: Applicants' argue: The 35 USC112, first paragraph rejection, for alleged failure to comply with the enablement requirement is respectfully traversed because specifically, a folder search device is part of the hardware structure of the document system shown in Figure 2 has been considered but is not persuasive.

Response: Figure 2 does not show a "folder search device" in the drawing figure and "a folder search device" is not referenced in the specification which means this constitutes new matter and is not enabled by the specification. The only suggestions that can be made is to possibly have Fig. 1 (108) read "FOLDER SEARCHING DEVICE" or Figure 1 (103) read "CANDIDATE FOLDER SEARCH DEVICE and incorporate this in the specification. However, this will most likely raise the issue of new matter in the specification and drawings. Furthermore, the specification discusses what the candidate folder searcher does but not what the candidate folder searcher actually is because a person could interpret it as a human being or a search template but not a device. This constitutes a problem when trying to allow the applicant because there has to be enough support in the specification and drawings for a person to make or use the invention. Unfortunately, the "folder search device" is creating a problem since the claimed feature has to be fully supported and enabled by the Applicants' disclosure and drawings. The independent claim limitations should expressly either match Figure 1 or Figure 2 as the drawing figure to be printed when the application is allowed and the Examiner does not find where the claim limitations of claim 1 match the apparatus of Figure 1 or Figure 2.

"A recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if the prior art has the capability to so perform." MPEP 2114 and *Exparte Masham*, 2 USPQ2d 1647 (1987).

"While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone." MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

Issue no. 2: Applicants' argue: Applicants' submit that the applied references alone or in any permissible combination are not seen to disclose or suggest the features of the claims 1, 9, and 12 and are not seen to disclose or suggest at least the features of (i) searching a plurality of folders to identify at least one candidate folder suitable for storing a new document among the plurality of folders, by comparing a feature of the new document with an average of features of the documents stored in at least one candidate folder among the plurality of folders, (ii) displaying the at least one identified candidate folder, and (iii) storing the new document into a selected folder selected by a user among the at least one displayed candidate folder has been considered but is not persuasive. Response: Applicants' are arguing part of the claim amendments to claims 1, 9, and 12 which make the amended portions of the claim limitations moot. Mori discloses "searching the plurality of folders to identify at least one candidate folder from the plurality of folders suitable for storing the new document, by comparing a feature of the new document with an average of features of the documents stored in at least one candidate folder among the plurality of folders, wherein the at least one candidate folder has documents more similar to the new document than other documents in the plurality of folders (col. 4, line 41-col. 5, line 20); and controlling means for controlling to store the new document into a selected folder selected by a user from the plurality of folders

searched by said folder search device (col. 6, lines 25-47 and col. 9, lines 30-62) and displaying the at least one identified candidate folder (col. 6, lines 40-47 and col. 7, lines 16-27). Mori did not expressly disclose a search device. However, a search device is well known in the art of searching for documents as discussed in Waltz.

Issue no. 3: Applicants argue: Mori is seen to disclose classification of stored documents by displaying a document set satisfying a retrieval query in a virtual folder and Mori is believed to be silent on searching for a folder on a similarity between a new document and other documents stored in folders has been considered but is not persuasive. Response: Mori discloses searching for a folder on a similarity between a new document and other documents in col. 1, lines 31-43.

Issue no. 4: Applicants' argue: Mori is silent on display of a candidate folder suitable for storing a new document and there is not a corresponding display of a folder or folders after the query has been performed has been considered but is not persuasive.

Response: The display of a candidate folder suitable for storing a new document is addressed in issue no. 2 and there is not any need to readdress this argument again.

As for there not being a corresponding display of a folder or folders after the query being performed. The claim limitations "corresponding display of a folder or folders after the query (search) being performed is not found in the claim limitations.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

"However, the written description is not a substitute for nor can it be used to rewrite the chosen claim language. Though understanding the claim language may be aided by the explanation contained in the written description it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Resonate v. Alteon Websystems, Inc.*, 67 USPQ2d 1771 (Fed. Cir. 2003). *In re Prater*, 162 USPQ 541 (CCPA 1969). "We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim ... However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the Applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified."

Issue no. 5: Applicants' argue: Waltz has been studied, but is not seen to teach anything that, when combined with Mori, would overcome the deficiencies of Mori has been considered but is not persuasive. "The suggestion to combine need not be expressed and may come from the prior art, as filtered through the knowledge of one skilled in the art". See *Motorola, Inc. v. Interdigital Tech. Corp.* 43 USPQ2d 1481 (Fed. Cir. 1997).

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir 1989).

"A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1285, 1391 (2007). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* 127 S. Ct. at 1739, 82 USPQ2d at 1395.

"when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, 103 likely bars patentability." *Id.* 127 S. Ct. at 1740, USPQ2d at 1396.

Resort can be had to case law regarding the rational supporting the motivation for combining references as follows: "We have noted that evidence of a suggestion, teaching, or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved". *In re Dembiczak*, 50 USPQ2d 1614.

Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988). "Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be combined to formulate obviousness rejections absent an express suggestion in one

prior art reference to look to another specific reference. We reject that recommendation as contrary to our precedent which holds that for the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references." See, e.g., *In re Semaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

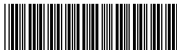
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

July 16, 2008

Application Number

Application/Control No.

08/863,047

Examiner

Ella Colbert

Applicant(s)/Patent under
Reexamination

ITO ET AL.

Art Unit

3696